

REMARKS

Claims 1, 4, 5 and 8-21 are pending.

Claims 1, 8 and 10 are independent claims from which the remaining dependent claims depend either directly or through intervening claims.

Entry of Amendment

The above amendment to claim 8 should be entered because it is a minor editorial change.

Reply to Rejections

First Rejection

Claims 1, 4, 5, 8-10 and 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber (U. S. Patent 5,794,210) in view of Reilly (U. S. Patent 5,740,549). This rejection is traversed.

For example, in base claim 1, the Examiner details his rejection and at least correctly recognizes that “Goldhaber does not explicitly disclose non-duplicate local storing of advertisements that the user has not yet viewed.” In asserting that this is shown in Reilly, the Examiner cites column 12, lines 15-20; column 15, line 55 – column 16, line 20; Figure 8; Figure 12.

The portions relied on in the rejection on Reilly are as follows:

Column 12, lines 15-20:

FIG. 8 includes an example of an advertisement (A001) assigned to two information categories (News and Sports). This advertisement is stored only once in the workstation's local hard disk, but is included in two of the linked lists of advertisements.

Column 15, line 55 – column 16, line 20:

Pseudocode Representation of Database Update Procedure

```
Connect to Information Server
If Update Type=Administrative/*i.e., not a news story only
update*/
{
    Client sends display statistics to server, and clears display
        statistics upon confirmation that server has successfully
            received them
    /*Pool Synchronization */
    Server Sends list of items (i.e., advertisement and scripts)
        that should be included in the client's advertisement
        and script pools
    Client deletes items in its advertisement and script pools
        that are not included in the list received from the Server
    Client determines what items are missing from its
        advertisement and script pools
    Client sends requests to Server for advertisements and
        scripts determined to be missing from local pools
    Server sends requested items to Client
    Client stores received advertisement and scripts in their
        respective disk directories
    Client opens all advertisement and script files to determine
        the static images referenced by those files, but not
        included in the local static image pool
    Client sends requests to Server for static images determined
        to be missing from local pool
    Server sends requested items to Client
    Client stores received static images in their assigned disk
        directory
    /*Software Module Synchronization */
    Client sends message indicate it is ready for software
        synchronization, including date and time of last
        administrative update
    Server sends new software modules, if any, based on date
        and time of last administrative update.
```

Figure 8 and Figure 12 are attached to the end of this Reply for the convenience of review.

It is submitted with respect to claim 1 that there is no *prima facie* case of obviousness established. A close examination of Reilly does not support the Examiner's contention of what is shown in Reilly. Accordingly, there is no *prima facie* case of obviousness because all the elements are not shown or suggested. Also, outside of the Applicants' own disclosure, there would be no motivating reason to modify the base reference with the suggestions in Reilly.

With respect to claims 8 and 10 which are independent claims, it appears that the Examiner has only picked and chosen from the references elements to support the rejection, which is impermissible. See, In re Wesslau, cited and explained on page 16 of the last Reply.

With respect to the dependent claims rejected, these claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. § 103.

Second Rejection

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber (U. S. Patent 5,794,210) in view of Reilly (U. S. Patent 5,740,549) in view of Gerace (U. S. Patent 5,848,396).

Claim 11 is dependent on claim 10. Claim 11 is considered patentable for at least the same reasons as base claim 10 and the addition of Gerace does not cure the innate deficiencies of the rejection based on claim 10.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. § 103.

Third Rejection

Claims 17-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber (U. S. Patent 5,794,210) in view of Reilly (U. S. Patent 5,740,549) in view of Steele (U. S. Patent 6,564,047) and in view of Rautila (U. S. Patent 6,524,189). This rejection is traversed.

Claim 17 is dependent on claim 1. Claim 18 is dependent on claim 17.

Claim 19 is dependent on claim 13. Claim 20 is dependent on claim 19.

Claim 21 is dependent on claim 1.

Initially, for the reasons advanced above, the base claims and intervening claims are considered patentable. The Examiner's additional reliance on Steele and Rautila does not cure the innate deficiencies of a rejection based on Goldhaber in view of Reilly.

While it is recognized that the Examiner can use a plurality of references based on the description set forth in the Office Action, again it appears that the Examiner has only picked and chosen so much from the references that will support the rejection, as explained in In re Wesslau cited above.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

On pages 13 and 14, the Examiner asserts why the claims are obvious. Initially, there is no evidence that one of ordinary skill in the art would have made the invention without benefit of the Applicants' own disclosure as a template in restructuring the art.

Also, the Examiner asserts that the references were attacked individually. This was not done and was not done in the first Reply.

It is considered that the Examiner's rejection is the epitome of the rejections reversed in the case of In re Wesslau, as explained above.

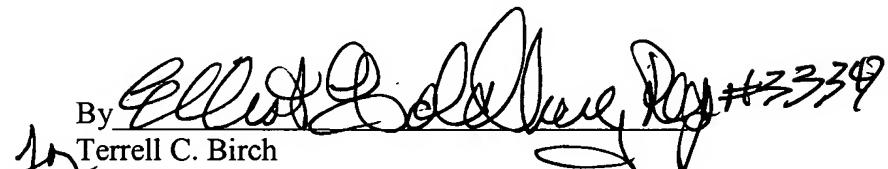
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 27, 2005

Respectfully submitted,

By 
Terrell C. Birch
Registration No.: 19,382
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachments: Figures. 8 & 12 of U.S. Patent 5,740,549 to Reilly